

<b>Notice of Allowability</b>	Application No.	Applicant(s)	
	10/632,197	MADUSKUIE, THOMAS P.	
	Examiner	Art Unit	
	James Balls	1625	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☐ This communication is responsive to \_\_\_\_\_.
2. ☒ The allowed claim(s) is/are 1-9 and 19-25.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
  - \* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.  
**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
  - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
    - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
  - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

- |  |  |
|--|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 6. <input type="checkbox"/> Interview Summary (PTO-413),<br>Paper No./Mail Date _____. |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),<br>Paper No./Mail Date _____ | 7. <input type="checkbox"/> Examiner's Amendment/Comment                               |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit<br>of Biological Material                     | 8. <input type="checkbox"/> Examiner's Statement of Reasons for Allowance              |
|  | 9. <input type="checkbox"/> Other _____.   |

### **DETAILED ACTION**

1. This application claims benefit of 60/400,237 filed on August 1, 2002.
2. The Information Disclosure Statement has been considered and a copy of the PTO-1449 is attached hereto. The previous examiner considered the information disclosure statement and either did not consider U.S. Patent No. 4,769,461 or considered the reference but neglected to initial the Form PTO-1449. U.S. Patent No. 4,769,461 has been considered and properly initialed on the Form PTO-1449.

### ***Reasons for Allowance***

3. The following is the examiner's statement of reasons for allowance:

The most closely related prior art is U.S. Patent No. 4,769,461 (Musser et al.), which discloses compounds structurally similar to applicants. Compounds exemplified by U.S. Patent No. 4,769,461 (Musser et al.) have one carbon linking a carbonyl group to the Z-group whereas applicants require at least two carbons between the carbonyl and Z-group. Also, applicants require that the first carbon extending from the Z-group be substituted with oxygen, a modification not provided by Patent No. 4,769,461 (Musser et al.). Finally, the prior art compounds have 5-lipoxygenase/cyclooxygenase inhibitory and leukotriene antagonist activity whereas the instant compounds are metalloproteinase inhibitors. Motivation to modify the prior art and use the compounds as metalloproteinase inhibitors is lacking.

There are two points of structural difference between Patent No. 5,358,955 (Brooks et al.) and the present case. First, the A-group of the instant case can contain a hydroxyl methanamine attached to the carbonyl, but the prior art provides for a N-methyl-N-methyl-methanamine linked to the carbonyl. The second point of difference is the middle carbon of Formula I, from which R1 and R2 extend. The prior art does not contain this additional carbon and its constituents. The compounds of the prior art are useable as lipoxygenase enzyme inhibitors whereas the present invention is directed toward metalloproteinase inhibition. Motivation to make the above-identified modifications is lacking.

Three points of structural difference exist between U.S. Statutory Invention Registration No. H1992H (Bender et al.) and the present invention. The compounds of the present invention link the Z-ring to the A-group via carbon chains, but the prior art links the Z-ring to the A-group with nitrogen and a sulfonyl group. Also, applicants require that U-X-Y form a linker of at least two atoms between Z and Za, whereas the prior art has only one linker. Motivation to make the above-identified modifications with a reasonable expectation of success is lacking.

### ***Conclusion***


4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Balls whose telephone number is (571) 272-7997. The examiner can normally be reached on Mon - Fri 8:00am - 4:30pm EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on (571) 272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

R. James Balls  
Examiner  
Art Unit 1625

  
Cecelia Tsang  
Supervisory Patent Examiner  
Art Unit 1625